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10/051,050	01/22/2002	Katsuyoshi Kitai	520.35137CX1	3473

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ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 NORTH SEVENTEENTH STREET  
SUITE 1800  
ARLINGTON, VA 22209-9889

EXAMINER

NGUYEN, PHUONGCHAU BA

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 05/26/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/051,050

Applicant(s)

KITAI ET AL.

Examiner

Phuongchau Ba Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-22-02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Claim Rejections – 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 2 recites “said second computer instructs the communication proxy registration waiting daemon of the third computer to generate the communication proxy process for and instructs to register the network address of the second computer and the communication parameters to the proxy registration table”, which is not found in the specification of the original application, see specification, on page 4, lines 20–22, wherein “the second computer generates the communication proxy process for the communication proxy registration waiting daemon of the third

computer and registers the network address of the second computer to the proxy registration table". Please point out the supported specification to claim 2 as recited above, and show how a computer generates a communication proxy process. It is noticed that a computer can execute a process/program, which was generated by a user. Therefore, please show in claim and supported specification of how the computer generated the communication proxy process (beside page 4, lines 19–22 in the specification, which has insufficient details to make and use the invention's generating feature).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 is vague and indefinite because it is not sure what is meant by "to generate the communication proxy process for and instructs to register the network address

of the second computer and the communication parameters to the proxy registration table". Please clarify what the communication proxy process is for?

### *Double Patenting*

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 6-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,404,766. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claim 1 merely broaden the scope of the patented claim 3 by eliminating "wherein said communication parameters include a parameter designating quality of service specified by ATM network". Likewise, application claim 6 merely broaden the scope of the patented claim 2 by eliminating "a correspondence table between a

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first communication port identifier used by said second computer for a communication with said first computer and a second communication port identifier used by said communication process for a communication with said first computer; and means for allowing a communication packet addressed to said second computer to be received by said communication process by converting the first communication port identifier written in said communication packet to second communication port identifier." It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference's element whose function is not needed would be obvious to one skilled in the art.

*Claim Rejections – 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 3-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Ames (6,058,429).

Regarding claim 1:

Ames discloses a network data communication system (100) for a network data communication, comprising:

a first computer (client 114) connected to a first network (VLAN 110);

a second computer (server 104) connected to a second network (VLAN 102); and

a third computer (126, 200) connected to both of said first and second networks (VLANs 110 & 102) for establishing communication thereinbetween,

wherein said third computer (server 104) includes a communication proxy having a proxy registration table and a communication proxy process for

receiving a communication packet addressed to said second computer (server 104),

wherein said proxy registration table contains a network address (L3) of said second computer and communication parameters (L2 address of router) designating a communication method to be employed in communication between said communication proxy process and said second computer,

wherein said third computer searches said proxy registration table when a communication packet which is not addressed to said third computer (when router 126/switch 200 receives a packet having L3 address of server 104, router 126/switch 200 look up for output port that connects router 126 and server 104, namely port 130) is received, and

wherein when a destination network address (L3 address) of the communication packet is registered in said proxy registration table, the communication proxy process (router 126/switch 200) receives the communication packet and transmits the communication packet to the destination (104) according to the communication method designated by said



communication parameters (L2 address of port 130) registered in said proxy registration table.

See col.2, lines 15–55, col.10, line 14–col.11, line 6.

Regarding claim 3:

Ames further discloses wherein when the communication proxy process receives a connection establishment request packet addressed to said second computer from said first computer, said communication proxy process establishes a connection between the communication proxy process and said first computer and further establishes a connection between said communication proxy process and said second computer {col.2, lines 15–55, col.10, line 14–col.11, line 6}.

Regarding claim 4:

Ames further discloses wherein said communication proxy process sends a communication packet addressed from said second computer to said

communication proxy process to said first computer {col.2, lines 15–55, col.10, line 14–col.11, line 6}.

**Regarding claim 5:**

Ames further discloses wherein when said second computer sends the communication packet address to said communication proxy process to said first computer, said communication proxy process rewrites a sender site network address of the communication packet to a network address of said second computer {col.2, lines 15–55, col.10, line 14–col.11, line 6}.

**Regarding claim 6:**

Ames discloses a third computer (126, 200) connected to both of a first network (VLAN 110) to which a first computer (client 114) is connected and a second network (VLAN 102) to which a second computer (server 104) is connected, comprising: a registration table (not shown, inherent in the router 126) for registering a network address (L3 address) of said second computer (server 104); means for searching the registration table when a communication

packet which is not directed to said third computer is received (when router 126/switch 200 receives a packet having L3 address of server 104, router 126/switch 200 looks up for output port that connects router 126 and server 104, namely port 130); a communication process for receiving a communication packet addressed to said second computer when a network address of a destination of the communication packet is registered in said registration table; and means for transmitting the communication packet to the destination {col.2, lines 15–55, col.10, line 14–col.11, line 6}.

**Regarding claim 7:**

Ames further discloses means for generating the communication process, wherein said third computer generates the communication process and registers the network address of said second computer to the registration table in accordance with a request from said second computer {col.2, lines 15–55, col.10, line 14–col.11, line 6}.

**Regarding claim 8:**

Ames further discloses wherein when said communication process receives a connection establishment request packet directed from said first computer to said second computer, said communication process establishes a connection between said communication process and said first computer and further establishes a connection between said communication process and said second computer {col.2, lines 15-55, col.10, line 14-col.11, line 6}.

**Regarding claim 9:**

Ames further discloses wherein said communication process sends a communication packet directed from said second computer to said communication process to said first computer {col.2, lines 15-55, col.10, line 14-col.11, line 6}.

**Regarding claim 10:**

Ames further discloses wherein said communication process converts a sender site network address to a network address of said second computer

when said second computer sends said communication packet addressed to the communication process to said first computer {col.2, lines 15-55, col.10, line 14-col.11, line 6}.

*Claim Rejections – 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ames (6,058,429) as applied to claim 1 above, and further in view of Templin (5,781,550).

Regarding claim 2:

Ames does not explicitly disclose wherein said third computer has a communication proxy registration waiting daemon for forming the communication proxy, and said second computer instructs the communication proxy registration waiting daemon of the third computer to generate the

communication proxy process for and instructs to register the network address of the second computer and the communication parameters to the proxy registration table. However, in the same field of endeavor, Templin (5,781,550) discloses wherein said third computer (gateway, fig.3) has a communication proxy registration waiting daemon (screen daemon 341) for forming the communication proxy {col.6, lines 35-38}, and said second computer (server 340) instructs the communication proxy registration waiting daemon (341) of the third computer (gateway) to generate the communication proxy process for and instructs to register the network address of the second computer and the communication parameters to the proxy registration table {col.5, lines 10-20, 64-col.6, line 4}. Therefore, it would have been obvious to an artisan to apply Templin's teaching to Ames with the motivation being to provide a transparent and secured communication between a trusted computer and an untrusted computer connected by a gateway.

*Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Perlman (5,309,437); Perlman (5,420,862); Perlman (5,500,860);

Civanlar (5,828,844); Mayes (5,793,763); Vu (5,623,601);

Gelb (5,550,984) ; Attanasio (5,371,852).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchau Ba Nguyen whose telephone number is 703-305-0093. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 703-308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*PN*

Phuongchau Ba Nguyen  
Examiner  
Art Unit 2665

**DUCHO**  
**PRIMARY EXAMINER**

*Lucho*  
*5-24-04*